

REMARKS

This responds to the Office Action mailed on July 14, 2004.

Claim 13 is amended. No claims are canceled or added. As a result, claims 1-5 and 7-36 are now pending in this application. Reconsideration of the application in view of the following remarks is requested.

§103 Rejection of the Claims

A. Rejection: Claims 1-3, 8-10, 13-16, 18, 24 and 33-36 were rejected under 35 USC § 103(a) as being unpatentable over www.photonet.com (archived March 2, 2000) in view of Altman (US 2001/0036324).

B. Response: To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference teachings so as to arrive at the claimed invention. Third, the art must provide a reasonable expectation of success. M.P.E.P. § 2143. The teaching or suggestion to arrive at the claimed invention and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure (M.P.E.P. § 2143, citing with favor *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Claim 1 recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image..." The Examiner admits that the www.photonet.com reference does not teach printing a receipt much less a receipt that includes thumbnails of the images stored (see page 3 of Office Action dated July 14, 2004). Despite the Examiner's statement to the contrary, the Altman reference also fails to teach or suggest printing a receipt with thumbnails of the digital images.

The Altman reference does not discuss a sales receipt. In fact, the word "sale" was found once as part of the word "wholesale" (see paragraph 74 of the Altman reference). The portion of the reference cited by the examiner for support discusses how images can be shown on a workstation (one is as a thumbnail). The workstation is also attached to a printer "...for

production of physical documents. These physical documents include labels...as well as read-outs of logical sets of records, that are retrieved from electronic storage 108.” (see paragraph 88 of Altman). There is no teaching or suggestion of a sales receipt or printing of a thumbnail of an image. Therefore the combination of the www.photonet.com reference and Altman fails to make out a *prima facie* case of obviousness since the combination simply falls short of the element recited in claim 1, namely “...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image.”

Furthermore, Applicant disagrees with the Examiner’s statement that it would have been obvious to utilize the printing of a sales receipt as taught by Altman since there is no such teaching.

In addition, the examiner fails to make out a proper *prima facie* case of obviousness since there is no suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference teachings so as to arrive at the claimed invention. In fact, the Altman reference teaches away from printing a receipt for images received. Altman teaches a system and process for storage and retrieval of physical paper documents, electro-optically generated electronic documents, and computer generated electronic documents. One of the main ideas of such a document retrieval system is to minimize the amount of paper needed to track the physical locations and to build a system and data base to provide an easy way to find documents as well as an easy way to access the physical documents. The idea of printing receipts of documents that are scanned is contrary to the purpose of such a document retrieval system. Rather than minimize the paper documents, this would add significant amounts of paper and increase the complexity of retrieving the documents in a fast and efficient manner. The system proposed by the Examiner would not “maximize the efficiency of storing and indexing documents” as the Examiner contends, but would decrease the efficiency of storing and indexing documents significantly. This teaching away of the Altman reference opposes a finding of a suggestion or motivation to combine or modify the prior art to yield the claimed combination. Accordingly, for the above stated reasons, the Examiner has failed to make out a proper case of *prima facie* obviousness with respect to claim 1.

Claims 2, 3, 8-10, 33 and 34 depend, either directly or indirectly, from claim 1 and include the limitations of claim 1 by their dependency. As a result, each of these claims now overcomes the rejection under 35 USC § 103 (a) since the examiner has failed to make out a proper *prima facie* case of obviousness.

The Examiner fails to set forth specific reasons for the rejection of claim 13 under 35 USC § 103 (a) in view of the combination of www.photonet.com (archived March 2, 2000) in view of Altman (US 2001/0036324). The Applicant requests more specificity in the rejection so that the rejection can be argued by the Applicant. Claim 13, as now amended, recites “...confirming storage of the at least one digital image at the remote site with a receipt.” Neither the www.photonet.com (archived March 2, 2000) reference nor the Altman (US 2001/0036324) reference teach or suggest confirming storage of the at least one digital image with a receipt. Accordingly, the Examiner fails to make out a *prima facie* case of obviousness since the combination of the www.photonet.com reference and the Altman reference simply falls short of the element recited in claim 13. Claims 14 and 35 depend from claim 13 and include the limitations of claim 13 and therefore the Examiner has also failed to make out a *prima facie* case of obviousness with respect to claims 14 and 35.

Claim 15 recites “...means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images.” The Examiner has failed to make out a proper *prima facie* case of obviousness with respect to claim 15 for the same reasons set forth above with respect to claim 1. Among other things, neither reference teaches or suggests means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images, as recited in claim 15.

Claims 16 and 18 depend directly from claim 15 and include the limitations of claim 15 by their dependency. As a result, each of these claims now overcomes the rejection under 35 USC § 103 (a) since the examiner has failed to make out a proper *prima facie* case of obviousness.

The Examiner fails to set forth specific reasons for the rejection of claim 24 under 35 USC § 103 (a) citing the combination of www.photonet.com (archived March 2, 2000) in view of Altman (US 2001/0036324). The Applicant requests more specificity in the rejection so that the rejection can be argued by the Applicant. Claim 24 includes the limitation of “a program encoded in computer memory...instructing the processor to...receive confirmation of storage of the paid-for digital images from the remote site.” Neither the www.photonet.com (archived March 2, 2000) reference nor the Altman (US 2001/0036324) reference teach or suggest the element set forth above. Accordingly, the Examiner fails to make out a *prima facie* case of obviousness since the combination of the www.photonet.com reference and the Altman reference simply falls short of the element recited in claim 24. Claim 14 depends from claim 13 and includes the limitations of claim 13 and therefore the Examiner has also failed to make out a *prima facie* case of obviousness with respect to claim 14.

The Examiner also fails to set forth specific reasons for the rejection of claim 36 under 35 USC § 103 (a) citing the combination of www.photonet.com (archived March 2, 2000) in view of Altman (US 2001/0036324). The Applicant requests more specificity in the rejection so that the rejection can be argued by the Applicant. Claim 36 depends from claim 19. Claim 36 therefore includes the limitation of claim 19 to a “...processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...” Neither the www.photonet.com (archived March 2, 2000) reference nor the Altman (US 2001/0036324) reference teach or suggest the element set forth above. Accordingly, the Examiner fails to make out a *prima facie* case of obviousness since the combination of the www.photonet.com reference and the Altman reference simply falls short of the element of claim 36 as recited in claim 19.

C. Rejection: Claims 1-3, 8-13, 13-16, 18, 24 and 33-36 were rejected under 35 USC § 103(a) as being unpatentable over Shiota et al. (US 2002/0032905) in view of Altman (US 201/0036324).

D. Response: This rejection is substantially the same as rejection A set forth above with the exception that the Shiota et al. reference is substituted for the www.photonet.com (archived March 2, 2000) reference. The Examiner admits that Shiota et al. reference does not teach printing a receipt much less a receipt that includes thumbnails of the images stored (see page 6 of Office Action dated July 14, 2004). Despite the Examiner's statement to the contrary, the Altman reference also fails to teach or suggest printing a receipt with thumbnails of the digital images. The arguments set forth above (B. Response) are equally applicable here. In short, the combination of Shiota et al. (US 2002/0032905) in view of Altman (US 201/0036324) fails to make a proper *prima facie* case of obviousness out with respect to claims 1-3, 8-13, 13-16, 18, 24 and 33-36 for the very same reasons as set forth above (B. Response).

E. Rejection: Claims 1-3, 7-11, 13-16, 18, 19-21 and 24-36 were rejected under 35 USC § 103(a) as being unpatentable over Bidun (WO 200163518 A2) in view of Altman (US 2001/0036324).

F. Response: The Examiner admits that the Bidun reference does not teach printing a receipt much less a receipt that includes thumbnails of the images stored (see top of page 9 of Office Action dated July 14, 2004). Despite the Examiner's statement to the contrary, the Altman reference also fails to teach or suggest printing a receipt with thumbnails of the digital images. The arguments set forth above in the section entitled "**B. Rejection**" with respect to claim 1 is equally applicable here. Claims 2, 3, 7-11, and 25-34 depend from claim 1 and include its limitations and therefore also are not obvious since the Examiner failed to set forth a proper *prima facie* case of obviousness.

In addition, the arguments set forth above in the section entitled "**B. Rejection**" with respect to independent claims 13, 15, and 24 is equally applicable here. Claims 14, 16, 18, 35 depend from the independent claims 13, 15, and 24 and include its limitations.

Claim 19 recites a "...processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site..." Neither the Bidun reference nor the Altman (US 2001/0036324) reference teach or suggest the element set forth

above. Accordingly, the Examiner fails to make out a *prima facie* case of obviousness since the combination of the Bidun reference and the Altman reference simply falls short of the element of claim 19. Claims 20-21 and 36 depend from claim 19 and therefore the Examiner fails to make out a *prima facie* case of obviousness with respect to claims 20-21 and 36 since the combination of the Bidun reference and the Altman reference simply falls short of the element of claim 19.

The argument set forth above in the section entitled “**B. Rejection**” with respect to claim 24 is also equally applicable here.

In addition, in this particular rejection, the Examiner seems to take official notice of many aspects of the teachings of programs and CPUs that are not specifically stated in the Bidun reference. Applicant respectfully traverses this official notice and requests the Examiner to provide a reference that describes these elements. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

G. Rejection: Claims 4, 5, 17 and 22 were rejected under 35 USC § 103(a) as being unpatentable over Shiota et al. or Bidun in view of www.telepix.com, and further in view of Michael Meyer, Dialing for Dmarks: Atlantic Edition, *Newsweek*, January 12, 1998, pg 8, and Chet Dembeck, A Technological Tale, Mom and Pops Splurge on ‘90’s Gadgetry and Hope for a Storybook Ending, *Washington Business Journal*, August 17, 1998.

H. Response: The Examiner admits that neither the Bidun reference nor the Shiota et al. reference teach printing a (see page 14 of Office Action dated July 14, 2004). The Examiner cites the www.telepix.com reference for the teaching of a receipt. The only discussion of a receipt appears to be on page 3 of the reference marked 2X. There is no discussion of printing a receipt or a discussion detailing the form of the receipt in the www.telepix.com reference (2X). The remaining references appear to rail on the need for an itemized receipt. It would seem these teach away from having a receipt however the Examiner seems to argue the arguments against an itemized receipt in the references provide the motivation or suggestion to provide an itemized receipt.

First of all, applicant submits that one of ordinary skill would not combine the references arguing against a receipt with the other references. However, even if one were to make the combination, the combination falls short of the invention as claimed. Claims 4 and 5 depend from claim 1 which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image..." There is no mention of this complete element in the references nor may the references be combined to yield the element in whole.

Claim 17 depends from claim 15. Claim 17 includes the elements of 15 which recites "...means for printing sales receipts for the transactions that include information identifying the stored images, the identifying information including thumbnail images of the stored digital images." Again, there is no mention of this complete element in the references nor may the references be combined to yield the element in whole.

Claim 22 depends from claim 19. Claim 22 includes the elements of claim 19 which recites a "...processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site..." Claim 22 also recites "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." The complete recitations included in claim 22 do not appear to be specifically taught in the references cited. Accordingly, since the combination of references falls short of the claim language, the claims overcome the Examiner's rejection under 35 USC § 103(a).

I. Rejection: Claims 6 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Shiota et al. or Bidun in view of www.telepix.com, and further in view of Michael Meyer, Dialing for Dmarks: Atlantic Edition, *Newsweek*, January 12, 1998, pg 8, and Chet Dembeck, A Technological Tale, Mom and Pops Splurge on '90's Gadgetry and Hope for a Storybook Ending, *Washington Business Journal*, August 17, 1998 and further in view of Bill Baird, The E-Marketer's Swipe File: Cutting-Edge Intelligence for the New Economy, Target Marketing, Vol. 23, No. 12, December 2000, pg. 20/ Jill Welch, Craving the latest and the Greatest? Try the Advanced Photo System, Vol. 18, Issue 45, November 4, 1996, pg. 91/perfect

Prints, Time, November 3, 1997, pg. 75/ Iomega and Lexmark Deliver Industry's First Pc-Free Digital Photo Processing Solution, Business Wire October 6, 1998, pg.

J. Response: Claim 6 was previously canceled so this rejection is moot with respect to that claim. Claim 23 depend from claim 22 and claim 19 and it includes the limitations of these two claims. The cited references do not appear to teach the entire recitation of the limitations included in claims 19 and 22 as discussed above. As a result, claim 23 now overcomes the rejection set forth in section I. above.

K. Rejection: Claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Shiota, et al. or Bidun as applied to claims 1 and 11 above, and further in view of Eastman Kodak: Kodak to Acquire 51% Stake in Picture Vision, *M2 Presswire*, February 13, 1998, pg. 1.

L. Response: Claim 12 depends indirectly from claim 1 which recites "...printing a sales receipt for the transaction that includes a thumbnail of the at least one digital image to confirm storage of the at least one digital image..." The Examiner admits that neither the Bidun reference nor the Shiota et al. reference teach printing a (see page 14 of Office Action dated July 14, 2004). As a result, the Examiner fails to make out a prima facie case of obviousness for the same reasons as set forth above (such as in B. Response and others) since the Eastman Kodak: Kodak to Acquire 51% Stake in Picture Vision, *M2 Presswire*, February 13, 1998, pg. 1 fails to provide this missing element.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

JOHN F. MEYER

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6977

Date

9/14/04

By



Richard E. Billion
Reg. No. 32,836

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